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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/734,290      | 12/11/2000  | George Bradley Hobbs | 10003973-1          | 3711             |

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

YOUNG, JOHN L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3622

DATE MAILED: 10/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/734,290

Applicant(s)  
Hobbs

Examiner  
John Young

Art Unit  
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 11, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*John Young*  
9-29-2003

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## **FIRST ACTION REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claims 1-34 are rejected under 35 U.S.C. §103( a ) as being obvious over Motamed US 6,519,053 (02/11/2003) [US f/d: 10/19/2000] (herein referred to as “Motamed”).

As per claim 1, Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) shows “A method of processing a print job of a customer and directing advertising to the customer, the method comprising the steps of: defining a print processing system controller having an advertisement registered therewith; defining a network communication link between the customer and the print processing system controller; processing a job ticket for the print job with the print processing system controller; and presenting the advertisement to the customer via the network communication link when the print processing system controller processes the job ticket for the print job.”

Motamed lacks an explicit recitation of “presenting the advertisement to the customer via the network communication link when the print processing system controller processes the job ticket for the print job. . . .” even though Motamed (col. 3, ll. 23-35) suggests the same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (col. 3, ll. 23-35) would have been modified and selected in accordance with “presenting the advertisement to the customer via the network communication link when the print processing system controller processes the job ticket

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for the print job. . . .” because such modification/selection of the disclosure of Motamed (col. 3, ll. 23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35) ).

As per claims 2-10, Motamed shows the elements and limitations of claim 1 and subsequent claims depending from claim 1.

Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests the elements and limitations of claims 2-10.

Motamed lacks an explicit recitation of the elements and limitations of claims 2-10 even though Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests same. It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) would have been modified and selected in accordance with the elements and limitations of claims 2-10 because such modification/selection of the disclosure of Motamed (col. 3, ll.

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23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35) ).

As per claim 11, Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) shows “A method of processing a print job of a customer and directing advertising to the customer, the method comprising the steps of: defining a print processing system controller having an advertisement registered therewith; defining a network communication link between the customer and the print processing system controller; processing a job ticket for the print job with the print processing system controller and selecting at least one of the advertisements based on the job ticket; and presenting the at least one of the advertisements to the customer via the network communication link.”

Motamed lacks an explicit recitation of “presenting the advertisement to the customer via the network communication link. . . .” even though Motamed (col. 3, ll. 23-35) suggests the same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (col. 3, ll. 23-35) would have been modified and selected in accordance with “presenting the advertisement to the customer via the network communication link. . . .” because such modification/selection of the disclosure of

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Motamed (col. 3, ll. 23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35) ).

As per claims 12-20, Motamed shows the elements and limitations of claim 11 and subsequent claims depending from claim 11.

Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests the elements and limitations of claims 12-20.

Motamed lacks an explicit recitation of the elements and limitations of claims 12-20 even though Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) would have been modified and selected in accordance with the elements and limitations of claims 12-20 because such modification/selection of the disclosure of Motamed (col. 3, ll.

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23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35) ).

As per claim 21, Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) shows “A system for processing a print job of a customer and directing advertising to the customer, the system comprising: a print processing system controller configured to have an advertisement registered therewith; wherein the print processing system controller is adapted to process a job ticket for the print job and present the advertisement to the customer when the print processing system controller processes the job ticket for the print job.”

Motamed lacks an explicit recitation of “and present the advertisement to the customer when the print processing system controller processes the job ticket for the print job. . . .” even though Motamed (col. 3, ll. 23-35) suggests the same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (col. 3, ll. 23-35) would have been modified and selected in accordance with “and present the advertisement to the customer when the print processing system controller processes the job ticket for the print job. . . .” because such modification/selection of the disclosure of Motamed (col. 3, ll. 23-35) would have



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provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35) ).

As per claims 22-34, Motamed shows the elements and limitations of claim 21 and subsequent claims depending from claim 21.

Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests the elements and limitations of claims 22-34.

Motamed lacks an explicit recitation of the elements and limitations of claims 22-34 even though Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Motamed (FIG. 2; FIG. 3; FIG. 5B; FIG. 7A; FIG. 9; FIG. 10A; FIG. 10B; FIG. 10C; FIG. 11; FIG. 12A; FIG. 12B; FIG. 12C; FIG. 1A; FIG. 1B; FIG. 1C; FIG. 1D; FIG. 1E; col. 3, ll. 23-35; col. 13, ll. 12-32 and whole document) would have been modified and selected in accordance with the elements and limitations of claims 22-34 because such modification/selection of the disclosure of Motamed (col. 3, ll.

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23-35) would have provided means for directing advertising and promotional literature to customers via the Internet. (See Motamed (col. 3, ll. 23-35) ).

### CONCLUSION

3. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

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(703) 746-7239 (for formal communications marked AFTER-FINAL) or

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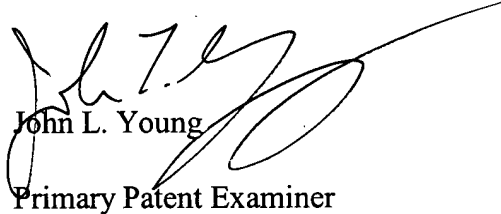
Arlington, Virginia.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
John L. Young  
Primary Patent Examiner

September 29, 2003